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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

BAKER, ANNE MARIE

ART UNIT

PAPER NUMBER

1632

DATE MAILED: 09/09/2002

2/15

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

08/963,288

Applicant(s)

NORSTEDT ET AL.

Examiner

Anne-Marie Baker, Ph.D.

Art Unit

1632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 August 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
 2. ☒ The proposed amendment(s) will not be entered because:
 (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☒ they raise the issue of new matter (see Note below);
 (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
 4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
 6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
 7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 34-36, 41, 42, 46-48 and 50.

Claim(s) objected to: _____

Claim(s) rejected: 1, 2, 5, 7-11, 15-17, 19-21, 23-32, 39, 40, 44, 45, 49, 52 and 53.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
 9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
 10. ☐ Other: _____

Anne-Marie Baker
ANNE-MARIE BAKER
PATENT EXAMINER

Art Unit: 1632

Continuation Sheet (PTO-303)

Continuation of 2. NOTE:

The proposed claim amendments, if entered, would require new grounds of rejection under 35 U.S.C. 112, second paragraph. The proposed amendment to Claim 8 introduces new matter into the claims. Claims 9-11, 16, and 17 depend from Claim 8. Claim 8, as amended, is directed to an expression vector comprising a structural gene encoding a desired protein or polypeptide and a promoter, wherein the vector further comprises six enhancer elements, and further wherein each of the enhancer elements consists essentially of the nucleotide sequence TTCTGAGAA or the nucleotide sequence of SEQ ID NO: 1. Thus, the claim covers vectors that comprise 3 enhancers consisting essentially of the core sequence TTCTGAGAA in combination with 3 enhancers consisting essentially of the nucleotide sequence of SEQ ID NO: 1, or 4 of one and 2 of the other, or 5 of one and 1 of the other, etc. in any arrangement, as long as there are six enhancer elements, each consisting essentially of TTCTGAGAA or the nucleotide sequence of SEQ ID NO: 1. However, the specification does not contemplate expression vectors that comprise various combinations of these two nucleotide sequences. On the contrary, the specification only provides support for an expression vector comprising six enhancer elements, where all six enhancer elements consist of the nucleotide sequence TTCTGAGAA and an expression vector comprising six enhancer elements, where all six enhancer elements consist of a 50 bp SPI-GHRE element. See Example 2 of the specification. Additionally, it is noted that the the nucleotide sequence of SEQ ID NO: 1 is 52 nucleotides in length, not 50.

Continuation of 5. does NOT place the application in condition for allowance because:

the arguments presented are directed to the claims as amended, but the proposed claim amendments have not been entered. All rejections are maintained for reasons of record.